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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,395	06/20/2000	Michael J. Natan	PSU 00 2182A	6068

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 07/24/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/598,395

Applicant(s)
Natan et al.

Examiner
Ardin Marschel

Art Unit
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 9, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above, claim(s) 37-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☒ Claims 1-86 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jun 20, 2000 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) 10 sheets 6) ☐ Other:

As a first note, the Examiner Interview Summary of 3/22/02 (Paper Number 15), was mailed on 3/25/02 which indicated that the requirement for acceptable formal drawings as required in the communication (Paper Number 12), mailed 12/31/01, had been acceptably met. The requirement for further drawing correction, mailed 12/31/01, therefore was withdrawn as of said Examiner Interview Summary of 3/22/02, mailed 3/25/02.

Applicants' election without traverse of Group I (claims 1-36) in Paper No. 10, filed 10/9/01, is acknowledged.

Claims 1-36 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 1, the word "freestanding" is cited as describing the therein claimed particle. This limitation indicates a standing which is free in some way. Standing itself is interpretable as indicating that the particle is "standing" on an end or some other part thereof. No such end or portion of the claimed particle has been defined in the claims thus making them vague and indefinite regarding what "standing" is meant. Alternatively, the term "freestanding" may be meant to be free of attachment to a support or other material. It is noted that a particle in a solution is well known to be wetted to some degree by that solution. Therefore particles in a solution apparently

are not freestanding. It is noted that two references were cited in the instant specification on page 23, lines 22-25, regarding particle synthesis, both of which prepare the particles electrolytically or via electrochemical coating. Such solutions clearly interact heavily with the particles and seem to conflict with the particles as being prepared as freestanding particles. Clarification via clearer claim wording is requested.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-12, 14, 18-23, 27, and 29-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee (P/N 4,053,433).

In the abstract and Figure 4, in particular, segmented

microparticles are described and depicted. In the SUMMARY OF THE INVENTION section in column 2 the color codes of the segments are recorded and utilized for identification. It is noted that color is seen via the reflectance of light from such particles and thus describes functionalization of such color practices for microparticles of Lee. A variety of materials are utilized in such microparticles as listed, for example, in column 3, lines 24-61, including inorganic and organic dyes. Other materials in the microparticles include polystyrene as noted in column 5, lines 1-11 and required in instant claim 22. The metallic content of some microparticles is described in column 28-48, including magnetic metals, such as iron powder or iron oxide. The dimensions of the coded microparticles of Lee are indicated in column 2, lines 50-58, as being in the range of 1 - 1000 μm with a preferred range of 50-250 μm . It is noted that microparticles with dimensions below 50 μm are also suggested as being more difficult to read but only that "more sophisticated magnification apparatus may be required". Thus, microparticles with dimensions below 50 μm are deemed included within the suggested types in Lee. It is noted that the upper dimensions in instant claim 1 for both particle length and width are 50 μm . Therefore the broadest dimension may be either a length or width as instantly claimed and as described in Lee. The wording in Lee as to broadest dimension is suggestive that other dimension(s) of

the described particles are smaller than these cited broadest dimensions, but only generically described via this suggestion to thus include any dimension less than those cited in Lee as "broadest dimension" thus including those as instantly claimed.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to prepare microparticles as in Lee with the dimension range therein motivated and suggested with the above noted added features to result in the practice of the above listed instant claims.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of copending application Serial No. 09/677,198. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the freestanding particle embodiments in the respective sets of claims are directed to overlapping particle length embodiments as clearly indicated in the respective claims 1. Instant claim 1 has a lower particle length of 20 nm. The lower particle length of claim 1 of 09/677,198 is 10 nm, both claims having the same upper length of 50 nm. The claims 2-36 in each claim set is otherwise identical.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

On the PTO Form 1449, filed 11/20/00, three applications were cited and lined through due to not having a date of publication which is required on such a form. These three applications: 09/677,198; 09/677,203; and 09/676,890; however, have been considered.

The disclosure is objected to because of the following informalities:

In claim 22, line 2, the word "polystyene" appears to be misspelled.

Appropriate correction is required.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located


in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

July 22, 2002


ARDIN H. MARSCHEL
PRIMARY EXAMINER